

**PATENT****REMARKS**

Reconsideration of the rejections set forth in the Office action dated 3/8/2005 is respectfully requested under the provisions of 37 CFR §1.111(b).

Claims 1-40 are pending.

Claims 4, 5, 11, 16, 17, 22 and 24 have been previously canceled.

Claims 1-3, 6-10, 12-15, 18-21, 23, and 25-40 have been rejected.

Claim 34 was amended to correct a typographical error noticed by the Examiner.

Applicant petitions for a one month extension.

***I. Rejections under 35 USC § 102(b)***

Claims 1, 2, 6, 8-10, 12-14, 18-20, 25, 26, 28, 29, 32-36, and 38-40 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,521,372 to Hecht et al., hereinafter Hecht.

A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art.

Applicant respectfully traverses the rejection of claims 1-22 as a prima facie case has not been established.

Previously presented claim 1 is:

A record for marking encoded information comprising:

a marking medium;

first marks on said marking medium having a covert code characteristic, said first marks conveying a covertly marked code; said covert code characteristic including a feature of the covertly marked code that is visually undetectable by a human; and

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second marks on said medium that convey an overtly marked code; said overtly marked code, when decoded, producing data for use in decoding said covertly marked code.

Hecht does not anticipate previously presented claim 1 because:

- 1) Hecht does not teach a covert code characteristic;
- 2) Hecht does not teach the use of a covert code; and
- 3) Hecht does not teach an overtly marked code that is decoded to produce data for use in decoding the covertly marked code.

Hecht is directed to the problem of embedding synchronization information (encoded by overt glyphs) within a glyph field to allow data that is also encoded in the glyph field by overt glyphs to be retrieved. The glyphs that carry synchronization information can be the same that carry data information (Column 5, line 65 to column 6, line 7).

Hecht's glyphs are visible. These visible glyphs carry information. Hecht's glyphs are arranged into two different classes of information, the synchronization information and the data information. None of the marks that make up these glyphs have a covert characteristic. All of glyphs disclosed by Hecht only have overt characteristics. They can be seen, easily copied, and counterfeited. Nothing in Hecht (column 4, lines 46-61, column 5, line 48 to column 6, line 8 teach or suggest anything related to glyphs that have covert code characteristics.

Hecht's column 4, lines 46-61, "where the glyphs are defined by respective symbols that are selected from a finite set of optically discriminable symbols to encode said information" explicitly teaches against the limitation of "said covert code characteristic indicating a feature of the covertly marked code that is visually undetectable by a human" because the optically discriminable symbols are overt as they can be optically detected.

Because Hecht does not teach a covert code characteristic, it cannot teach the use of a covertly marked code that can be decoded from marks that have a covert code characteristic

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Because Hecht does not teach a covert code, it cannot teach an overtly marked code that produces data for use in decoding the covertly marked code.

Hence, Hecht does not anticipate **previously presented claim 1**. For similar reasons, Hecht does not anticipate **previously presented claim 12**. Thus, applicant respectfully traverses the anticipation rejection applied to claims 1 and 12.

Because the independent claims are not anticipated, **claims 8-10, 13, 19, 20, 25, 26, 28 and 29** are not anticipated. Furthermore, claims 8, 19, 9, 20, 10, 13, 25, 28, 26 and 29 also rely (directly or indirectly) on the covert code characteristic that is not taught by Hecht. Thus, applicant respectfully traverses the rationale provided in each separate anticipation rejection.

***II. Rejections under 35 USC §103(a)***

Claims 3 and 15 stand rejected under 35 USC §103(a) as being unpatentable over Hecht in view of Wright (5,225,900). This rejection is respectfully traversed in view of the following arguments.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Wright teaches the use of taggants to distinguish between different types of markings on a marking medium.

**Claims 3 and 15** depend on and further limit their parent claims that are patentable. Thus, claims 3 and 15 are also patentable and applicant respectfully traverses this rejection to **claims 3 and 15**. In addition, while Wright teaches the use of taggants, it does not teach or suggest, alone or combined with Hecht, the use of a covert code that can be decoded from marks having the covert characteristic, nor does it teach using an overtly marked code that can be decoded to produce data for decoding the covertly marked code. Neither Hecht nor Wright, separately or combined teach or teach a suggestion that would have made the claimed invention obvious to one skilled in the art.

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**Claims 7 and 21** stand rejected under 35 USC §103(a) as being unpatentable over Hecht in view of Moore (5,895,073). This rejection is respectfully traversed in view of the following arguments.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Moore teaches the use of authentication data that can be seen under normal light, special light, or scanned to help reduce counterfeiting.

Claims 7 and 21 depend on and further limit their parent claims that are patentable. Thus, these claims are patentable and applicant respectfully traverses the rejection of **claims 7 and 21**. In addition, neither Hecht nor Moore, separately or combined teach or teach a suggestion of using an overly marked code to provide data used in decoding the covertly marked code.

**Claim 23** stands rejected under 35 USC §103(a) as being unpatentable over Hecht in view of Parker (4,761,668). This rejection is respectfully traversed in view of the following arguments.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Claim 23 depends on and further limits its parent claim that is patentable. Thus, claim 23 is patentable and applicant respectfully traverses the rejection to **claim 23**.

**Claims 27, 30, 31 and 37** stand rejected under 35 USC §103(a) as being unpatentable over Hecht. This rejection is respectfully traversed in view of the following arguments.

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A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Previously presented claim 31 is an independent claim.

A method for marking encoded information on a marking medium comprising the steps of:

placing first marks on said medium having a covert code characteristic including a feature of the covertly marked code that is visually undetectable by a human; a subset of said first marks conveying a covertly marked code; and

placing second marks on said medium adapted to convey an overtly marked code; said overtly marked code, when decoded, producing an encrypted message and decryption data used by a secure server to decrypt the encrypted message; the decrypted message causing the secure server to produce decoding data indicating which ones of said first marks are included in the subset of said first marks that convey said covertly marked code.

Hecht has previously been discussed. Nothing in Hecht would teach or teach a suggestion to one skilled in the art to use the decrypted message to cause a server to produce decoding data that indicates which of the marks that have a covert code characteristic are to be decoded to produce a covertly marked code. Thus, applicant respectfully traverses the rejection to **claim 31**.

Previously presented claim 37 depends on and further limits claim 1 that is patentable. Thus, claim 37 is patentable and applicant respectfully traverses this rejection to **claim 37**. In addition, applicant respectfully traverses the rationale for the rejection of claim 37 as the rejection appears to be based on a misunderstanding of the invention. Applicant respectfully requests the Examiner to review page 3, lines 10-13.

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Previously presented claim 27 depends on, and further limits previously presented claim 1 that is patentable. Thus, claim 27 is patentable and applicant respectfully traverses the rejection of **claim 27**.

Previously presented claim 30 depends on, and further limits previously presented claim 12 that is patentable. Thus, claim 30 is patentable and applicant respectfully traverses the rejection of **claim 30**.

The undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

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